

limitations were not included in any of the previously prosecuted claims, nor are they broadened versions of previously prosecuted limitations. Applicant is willing to add a recitation of a specific example if the examiner indicates that one must be actually recited in the declaration. This can be done after there is an indication of allowable subject matter.

The examiner has rejected all of the new claims under 35 USC 252 as being improper recapture of subject matter deliberately surrendered in the application for the patent upon which the present reissue is based. Relying on *Hester Industries, Inc. v. Stein, Inc.*, 142 F.2d 1427, 46 USPQ2d 1641 (Fed. Cir. 1998), the examiner has revised his recapture rejection so as to rely on surrender of subject matter by way of *arguments* made during prosecution of the original patents (four patents issued from the original application). The examiner gives a long list of limitations on which applicant allegedly relied in arguing for the patentability of the claims in the issued patents, and takes the position that there is impermissible recapture because applicant has "fail[ed] to recite the identical or more narrow versions of at least one of the following limitations, argued by applicant to make claims allowable over the cited prior art."

The examiner is urged to reconsider and withdraw his rejection, for he has misapplied the law of recapture, and in particular the test for recapture laid down in *Hester*.

The recapture doctrine prohibits an applicant from recapturing in his reissue application what he surrendered in his original application. The examiner is quite correct in pointing out that surrender can occur when an applicant makes an argument in the original application that unequivocally establishes that certain subject matter is outside his invention. Thus, in *Hester*, where the applicant had *repeatedly* argued that cooking *with only steam* and *with two steam sources* set his claimed cooking apparatus apart from the prior art, the Federal Circuit found that the applicant had surrendered apparatus in which cooking was done with steam combined with another type of heat or with steam generated by only one steam source. The Court emphasized the unmistakable character of the applicant's surrender of the subject matter, by emphasizing the repeated instances in which these two limitations were relied upon to establish patentability, and their characterization as "critical" and "material":

Thus we conclude that, in a proper case, a surrender can occur through arguments alone. We next evaluate whether such a surrender occurred here with

respect to the "solely with steam" and "two sources of steam" limitations, the pertinent aspects in which the asserted reissue claims are broader than the original patent claims. The obvious conclusion is that there has been a surrender.

As detailed above, Williams *repeatedly* argued that the "solely with steam" and "two sources of steam" limitations distinguished the original claims from the prior art. These were Williams' primary bases for distinguishing the broadest claim, independent claim 1, from the prior *art*. *At no less than 27 places in six papers* submitted to the Patent Office, Williams asserted that the "solely with steam" limitation distinguished the claimed invention from the prior art, and Williams did the same with respect to the "two sources of steam" limitation *at no less than 15 places in at least five papers*.

Williams argued that each of these limitations was "*critical*" with regard to patentability, and Williams further stated that the "solely with steam" limitation was "*very material*" in this regard. In essence, these *repeated arguments* constitute an admission by Williams that these limitations were necessary to overcome the prior art. Indeed, when the Board reversed the Examiner's rejection of the original claims, these were the primary bases indicated for patentability. Williams, through his admission effected by way of his *repeated* prosecution arguments, surrendered claim scope that does not include these limitations.

But the Federal Circuit did not end its analysis there. It went on to evaluate whether recapture had been avoided by the claims being *materially narrowed in other respects*. The Court wrote:

Finally, because the recapture rule may be avoided in some circumstances, we consider whether the reissue claims were materially narrowed in other respects. See, e.g., *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525 ("Reissue claims that are broader in certain respects and narrower in others may avoid the effect of the recapture rule."); *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165. For example, in *Ball* the recapture rule was avoided because the reissue claims were sufficiently narrowed (described by the court as "fundamental narrowness") despite the broadened aspects of the claims. 729 F.2d at 1438, 221 USPQ at 296. In the context of a surrender by way of argument, this principle, in appropriate cases, may operate to *overcome the recapture rule when the reissue claims are materially narrower in other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects.*

Applicant : Jae S. Lim  
Serial No. : 09/335,376  
Filed : June 17, 1999  
Page : 4

Attorney's Docket No.: 01997-253005

As it turned out in *Hester*, the claims had not been narrowed in any material respect. The reissue claims were in substance the same as the claims of the patent except for being broadened so as *not* to require cooking *solely with steam and with two steam sources*.

The examiner's rejection fails to follow *Hester* in two very important respects.

First, the examiner has not established that each of the limitations listed in his long list was surrendered in original prosecution. Surrender requires arguments that unmistakably establish that the applicant regarded the limitation as necessary to patentability. It is not at all clear where the examiner obtained his list, but it certainly is not a list of limitations that the applicant by argument established were necessary to patentability.

Second, the examiner has altogether failed to examine the reissue claims to determine whether they have been narrowed in material respects. The examiner is incorrectly viewing the recapture doctrine as prohibiting any claim that fails to include a surrendered limitation. We know from *Hester* that this is not the law. Recapture can be avoided even when a surrendered limitation is missing from a broadened claim if the claim contains other limitations that materially narrow it. The examiner must determine whether there are such materially narrower limitations before he can reach the conclusion that there has been impermissible recapture. As noted in our prior response, each of the new claims does add at least one materially narrower limitation, as each is directed to an aspect of the invention overlooked during the original prosecution.

Accordingly, the application is submitted to be in condition for allowance.

Filed herewith is a Petition for Automatic Extension with the required fee. Please apply any other charges or credits to Deposit Account No. 06-1050.

Applicant : Jae S. Lim  
Serial No. : 09/335,376  
Filed : June 17, 1999  
Page : 5

Attorney's Docket No.: 01997-253005



Respectfully submitted,

Jae S. Lim, Reg. No. 44,210  
G. Roger Lee  
Reg. No. 28,963

Fish & Richardson P.C.  
225 Franklin Street  
Boston, MA 02110-2804  
Telephone: (617) 542-5070  
Facsimile: (617) 542-8906

20198250.doc